



**25 MAY 2007**

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In re Application of	:	
SCHUURMANN, et al.	:	DECISION ON PETITIONS
Serial No.: 10/510,577	:	
PCT No.: PCT/EP03/03751	:	UNDER 37 CFR 1.48(a)
Int. Filing Date: 10 April 2003	:	
Priority Date: 10 April 2002	:	AND 37 CFR 1.47(a)
Atty Docket No.: GULDE-0052	:	
For: N-(3-RIFAMYCINYL)-CARBAMATES,	:	
METHOD OF PREPARING THEM AND	:	
THEIR USE FOR TREATING AND	:	
PREVENTING TUBERCULOSIS	:	

This decision is in response to applicant's "PETITION UNDER 37 C.F.R. §1.47(a)" filed 08 March 2007 to accept the application without the signature of joint inventor Zoya Andonova Nedeyalkova.

### **BACKGROUND**

On 10 April 2003, applicant filed international application PCT/EP03/03751 which claimed priority to a previous application filed 10 April 2002. A copy of the international application was transmitted to the United States on 16 October 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 10 October 2004.

On 08 October 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an English translation of the international application and an Information Disclosure Statement.

On 16 February 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 15 July 2005, applicant filed a response including a combined declaration and power of attorney accompanied by a petition for a three-month extension of time.

On 20 September 2005, applicant was mailed a "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495" (Form PCT/DO/EO/903) indicating an date of completion of all 35 U.S.C. 371 requirements of 15 July 2005.

On 11 August 2006, applicant filed a petition under 37 CFR 1.48(a) to add Zoya Andonova Nedeyalkova as an inventor in the present application accompanied by an additional combined declaration and power of attorney, which listed Zoya Andonova Nedeyalkova as an inventor.

On 08 March 2007, applicant filed the present petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor Zoya Andonova Nedeyalkova indicating that while Ms. Nedeyalkova was listed on the declaration filed 11 August 2006, she had not executed said document.

## **DISCUSSION**

### **I. PETITION UNDER 37 CFR 1.48(a)**

Applicant is advised that while Zoya Andonova Nedeyalkova was inadvertently left off of the declaration filed in the U.S. National stage on 15 July 2005, she was listed as an inventor on the published international application; as such, the petition to add her as an inventor pursuant to 37 CFR 1.48(a) is **DISMISSED as moot**.

### **II. PETITION UNDER 37 CFR 1.47(a)**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1 and 3.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." 409.03(d) also states that:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal

was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.

In the present case, applicant has not provided any firsthand details regarding the presentation of papers to Ms. Nedeyalkova nor the nature of her purported refusal. The only evidence provided to support the contention that Ms. Nedeyalkova refuses to participate is the letter of Dr. Marlene K. Ziebig. However, this document merely recounts secondhand information from a Ms. Valcheva and therefore is not conclusive evidence for the purposes of 37 CFR 1.47. In order to proceed under 37 CFR 1.47, applicant must provide firsthand evidence that the non-signing inventor was presented with a complete set of application papers and either refused to accept the papers or refused to execute and return the oath or declaration. (The silence of the inventor coupled with proof of delivery of the application papers to the inventor in question constitutes a refusal under 37 CFR 1.47.

Regarding item (4), the declaration filed 11 August 2006 does not comply with 37 CFR 1.497 (a)-(b).

Specifically, MPEP Section 201.03 states that:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

The declaration filed 11 August 2006 contains three pages "3 of 4." This suggests that either the filed declaration was compiled from numerous declarations or that the inventors only returned their signature pages. Either scenario renders the document non-compliant.

In light of the above, it is not possible to grant applicant's petition at this time.

**CONCLUSION**

For the reasons stated above, applicant's petition under 37 CFR 1.48(a) is **DISMISSED as moot.**

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED.**

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Applicant is advised that in order for the renewed petition to be considered applicant must provide payment of the remaining \$70.00.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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